

Amendments to the Drawings

The attached replacement sheets of drawings 1 and 2 are hereby submitted to replace original sheets 1 and 2.

Remarks

Support for the Amendments

Support for the foregoing amendments to claims 1, 5, 7-9 and 13-15 can be found throughout the specification. Therefore, these amendments do not add new matter, and their entry and consideration are respectfully requested.

The amendments to the drawings are made to replace the solid black shading in Figures 1 and 2. The attached replacement sheets of drawings contain no new matter, and their entry and consideration are respectfully requested.

Status of the Claims

By the foregoing amendments, claims 1, 5, 7-9, 13-15 are sought to be amended. Claims 16-19 have been cancelled without prejudice or disclaimer. Applicants reserve the right to prosecute the subject matter of these canceled claims in other divisional or continuation applications. Upon entry of the foregoing amendments, claims 1-15 are pending in the application, with claim 1 being the sole independent claim.

Summary of the Office Action

In the Office Action dated March 30, 2005, the Examiner has made four rejections of the claims and one objection to the drawings. Applicants respectfully offer the following remarks to traverse each of these elements of the Office Action. Applicants respectfully request reconsideration of the present Application.

Reply to Restriction Requirement

Applicants hereby affirm the election to prosecute Group I, claims 1-12, made via telephone by Robert W. Esmond on February 7, 2005. Applicants also affirm that this election is made with traverse. Applicants submit that present claims 13-15 are directed to subject matter encompassed by Group I. Hence, Applicants respectfully request that, claims 13-15 be included in Group I and that claims 1-15 be examined at this time.

Rejection Under 35 U.S.C. § 101

In the Office Action at pages 3-4, sections 9 and 10, the Examiner has rejected claims 13-15 under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Applicants respectfully submit that present claim 13 is directed to a method of manufacturing an adhesiveless masking film. Present claims 14-15 are directed to methods of protecting a surface of a substrate. Hence, Applicants respectfully submit that these claims are directed to "new and useful processes" as set forth under 35 U.S.C. § 101, and hence, these claims are clearly directed to statutory subject matter. In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

In the Office Action at pages 4-5, sections 11-13, the Examiner has rejected claims 1-12 under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse this rejection.

The Examiner first asserts that the use of trademarks or trade names in claims 1-12 renders the scope of the claims indefinite, as the trademark or trade name cannot be used properly to identify any particular material or product. The Examiner therefore concludes that the claims are indefinite.

Applicants respectfully disagree with these assertions. However, in order to expedite prosecution, Applicants have replaced trademarks in the claims with the generic name of the corresponding material or product. Specifically, the trademark "MxsiteTM" has been replaced with the terms "polyethylene cling resin comprising amorphous polyolefin." Applicants respectfully submit that the ordinarily skilled artisan guided by the present specification, specifically page 4, paragraph 18, and knowledge generally available in the art (*see e.g.*, Somers, M.S., *et al.*, U.S. Patent No. 6,070,394, attached hereto as Exhibit A), would readily recognize that "MxsiteTM" is a "polyethylene cling resin comprising amorphous polyolefin." Applicants have removed the remaining trademarks from the claims. Hence, the rejection under 35 U.S.C. § 112, second paragraph, has been overcome. Reconsideration and withdrawal of this portion of the rejection are respectfully requested.

The Examiner has also rejected claims 8 and 9 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner asserts that it is unclear what is meant by the phrase "an advanced Zeigler Natta catalyzed." Applicants respectfully disagree with this assertion. However, solely to expedite prosecution, and not in acquiescence to this rejection, present claims 8 and 9 no longer

recite this phrase. Hence, this rejection has been rendered moot. Reconsideration and withdrawal of this portion of the rejection are respectfully requested.

Rejection Under 35 U.S.C. § 103(a) Over Ghiam, In View Of Eichbauer

In the Office Action at pages 5-6, sections 14 and 15 the Examiner has rejected claims 1-12 as being unpatentable over Ghiam, F.F. *et al.*, U.S. Patent No. 6,326,081 (hereinafter "Ghiam"), in view of Eichbauer, G.N., U.S. Patent No. 6,093,480 (hereinafter "Eichbauer"). Applicants respectfully traverse this rejection.

The Examiner contends that Ghiam discloses a masking film comprising a first layer made of a metallocene catalyzed copolymer of ethylene and a second layer made of a homopolymer or copolymer of polyethylene. The Examiner also contends that Ghiam "suggests" a multilayer structure having a core layer and a first and second layer on either side. The Examiner states, that Ghiam does not disclose the specific polymer composition of the core layer or the second layer. The Examiner relies on the disclosure of Eichbauer to cure these deficiencies in Ghiam.

The Examiner contends that Eichbauer discloses a stretch wrap film having one layer made of a linear low density polyethylene made using a constrained geometry catalyst (i.e., a metallocene catalyst), and also contends that Eichbauer suggests a multilayer film having an inner layer of a blend of a polyethylene cling resin and a low density polyethylene, an outer layer with cling property and another outer layer with slip property. The Examiner concludes that it would have been obvious for one of skill in the art "to utilize disclosure of Eichbauer in the invention of Ghiam et al. to make inner layer i.e., core layer and the second layer of polymer taught by Eichbauer for the inner layer

and for the slip layer." Office Action at page 6, section 15, lines 9-11. Applicants respectfully disagree with this conclusion and the Examiner's contentions.

The disclosure of Ghiam is directed to masking films for use in protecting smooth surfaces. As the Examiner has stated, Ghiam does not disclose the composition of the core layer or the second layer of the masking films. Specifically, Ghiam does not disclose the use of a polyethylene cling resin in any of the masking films disclosed therein. Furthermore, Applicants respectfully submit that Ghiam does not disclose a masking film comprising a first outer layer consisting of a polyethylene cling resin comprising amorphous polyolefin and a second outer layer that does not contain the polyethylene cling resin, wherein the first outer layer of the film is adapted for retackably adhering to a surface of a substrate, as recited in present claim 1 (and hence, claims 2-15 that depend ultimately therefrom). Therefore, Ghiam is seriously deficient as a primary reference on which to base a *prima facie* case of obviousness.

Applicants respectfully submit that Eichbauer does not cure these deficiencies in Ghiam. The disclosure of Eichbauer is directed to stretch wrap films, not masking films for adhesion to smooth surfaces. The various layers of the stretch wrap films in Eichbauer have a cling force relative to *each other*, not relative to a *separate* smooth substrate (*see* Eichbauer at column 2, lines 42-44). The ordinarily skilled artisan would not have been motivated to utilize any of the polymeric cling resins disclosed in Eichbauer in the masking films of Ghiam, as the two disclosures are directed to two unrelated polymeric-film technologies.

The masking films disclosed in Ghiam are designed for adhesion to rigid, relatively smooth-surfaced substrates, (*see* Ghiam at column 1, lines 8-12). In contrast,

the stretch wrap films disclosed in Eichbauer are designed for use in various article wrapping applications, (*see* Eichbauer at column 1, lines 10-37). Applicants respectfully submit that an ordinarily skilled artisan would have found no motivation to combine the disclosure Eichbauer with that of Ghiam, much less substitute the polymeric cling resins disclosed in Eichbauer for any of the layers of the masking films disclosed in Ghiam. The Examiner has provided no motivation to make such a substitution, nor has the Examiner provided any evidence of an expectation of success for such a substitution, either in the references themselves, or in the knowledge generally available in the art. Hence, Applicants respectfully submit that the Ghiam and Eichbauer, alone or in combination, do not render obvious the presently claimed invention.

In view of the foregoing remarks, Applicants respectfully submit that a *prima facie* case of obviousness has not been established based on the disclosure of Ghiam and Eichbauer, alone, or in combination. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Other Matters

In the Office Action at pages 6-7, sections 17-19, the Examiner has indicated that a certified copy of Canadian Patent Application No. 2,401,794 has not been received. In addition, the Examiner has indicated that the specification does not contain a reference to prior applications, in accordance with 35 U.S.C. § 119(e).

Applicants are filing concurrently herewith a certified copy of Canadian Patent Application No. 2,401,794. Applicants therefore believe that this requirement has been met.

With regard to the requirements of 35 U.S.C. § 119(e), Applicants respectfully submit that the requisite prior application information was provided on the Application Data Sheet filed with this application on September 8, 2003. A copy of this Application Data Sheet is provided herewith as Exhibit B, along with the USPTO date-stamped post card acknowledging receipt of the Application Data Sheet on September 8, 2003. As set forth in 37 C.F.R. §§ 1.76(b)(5)-(6), providing the priority information in an Application Data Sheet constitutes the specific reference required under 35 U.S.C. §§ 119(e), 120 or 365(c) (relating to claims for domestic priority) and the claim to priority under 35 U.S.C. § 119(b) and 37 C.F.R. § 1.55(a) (relating to claims for foreign priority). Thus, Applicants have in fact complied with all conditions for receiving the benefit of domestic and foreign priority.

Finally, in reply to the Examiner's objections to Figures 1 and 2, Applicants have filed herewith replacement pages of Figures 1 and 2. Applicants believe that these replacement drawings overcome the objections raised by the Draftsperson. Hence, this objection has been overcome.

Conclusion

All of the stated grounds of rejection and objection have been properly traversed, rendered moot or otherwise overcome. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn.

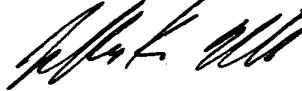
Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for

allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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